

Please add the following new claims:

*B2* —12. The composition of claim 1, wherein the platinum of constituent A1, B1, or C1 comprises catalytic platinum contained in the polyorganosiloxane composition.

13. The method of claim 5, wherein the vinyl groups are carried by the M, D, and/or T units—

#### REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1-11 were pending. By the present response, claims 12-13 have been added and claims 1-9 amended. Thus, upon entry of the present response, claims 1-13 remain pending and await further consideration on the merits.

#### ***CLAIM REJECTIONS UNDER 35 U.S.C. §112***

Claims 1-11 stand rejected under 35 U.S.C. §112, second paragraph on the grounds set forth in paragraph 1 of the Official Action.

By the present response, applicant has amended claim 1-11 in a manner which is believed to address the above noted rejection. Therefore, reconsideration and withdrawal of the rejection is respectfully requested. *ny*

***CLAIM REJECTIONS UNDER 35 U.S.C. §102***

Claims 1-3, 9 and 11 stand rejected under 35 U.S.C. §102(b) over U.S. Patent 4,110,300 to Matsushita (hereafter "*Matsushita*") on the grounds set forth in paragraph 4 of the Official Action.

For at least the reasons noted below, the rejection should be withdrawn.

The present invention is directed to a composition having good arc-tracking and arc-erosion resistance properties, while still having good flame-resistance properties and good mechanical properties, and its associated method. A composition consistent with the principles of the present invention is embodied, for example, in claim 1. Claim 1 recites, *inter alia*, a mixture A, B, or C containing platinum, expressed in parts by weight of elemental platinum, which lies within the range going from 1 to 250 ppm with respect to the total weight of the polyorganosiloxane constituent (S) of the curable compositions D. By contrast, *Matsushita* is directed to a self extinguishing silicon rubber composition which includes a finely powdered  $\gamma\text{-Fe}_2\text{O}_3$ . The comparative examples listed in Table 1, column 6, of *Matsushita* are cited as anticipating the subject matter of the claimed invention. This assertion is respectfully traversed.

As set forth in column 6 of *Matsushita*:

Molding compositions were prepared by adding to the thusly prepared base compound 0.5 part of a 1% solution of chloroplatinic acid.

By contrast, amended claim 1 requires a mixture containing platinum in an amount expressed in parts by weight of elemental platinum, going from 1 to 250 ppm. From the above, it does not appear that the composition of comparative examples 103 and 104 contain platinum in the

NP/  
claimed amount. Therefore, *Matsushita* fails to anticipate the subject matter of the presently claimed invention for at least this reason. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-3, 8, 9 and 11 stand rejected under 35 U.S.C. §102(e) over U.S. Patent No. 5,543,450 to Takita et al. (hereafter "*Takita et al.*") on the grounds set forth in paragraph 6 of the Official Action.

For at least the reasons noted below, the rejection should be withdrawn.

*Takita et al.* is directed to non-flammable silicon rubber compositions including an additive which comprises silica type fillers, a platinum based component, at least one additional metal element or metal compound (A), (B) and/or (C), as well as a particular azo-organic compound in the form of 2,2'-azobis(2-methyl butyronitrile).

NP/  
By contrast, claim 1 recites an additive in the form of a mixture A, B or C as defined by amended claim 1. Mixtures A, B and C, as defined in claim 1, preclude the addition of an azo-organic compound. Therefore, *Takita et al.* fails to anticipate the subject matter of the presently claimed invention for at least this reason. Reconsideration and withdrawal of the rejection is respectfully requested.

**CLAIM REJECTIONS UNDER 35 U.S.C. §103**

Claims 4-8 and 10 stand rejected under 35 U.S.C. §103(a) over *Matsushita* on the grounds set forth in paragraph 5 of the Official Action.

*Matsushita* fails to disclose, or even suggest, a composition including platinum in the amount recited, as explained above. Therefore, claims 4-8 and 10 are not obvious in view of *Matsushita* for at least the same reasons noted above.

It is expressly acknowledged in paragraph 5 of the Official Action that *Matsushita* teaches the use of an iron oxide which is different from that recited by the presently claimed invention. Despite this acknowledgment, it is asserted that the presently claimed invention would have been obvious to those of ordinary skill in the art in light of the teachings of *Matsushita*. This assertion is respectfully traversed.

It is submitted that one of ordinary skill in the art, when considering the disclosure of *Matsushita* as a whole, would have clearly been led away from a composition which includes a non- $\gamma$  iron oxide material. In this regard, it is noted that *Matsushita* expressly teaches that the comparative examples relied upon by the Examiner as anticipating or rendering obvious the presently claimed invention (i.e., comparative examples 103 and 104, Table 1, column 6) are markedly inferior to a material comprising the essential  $\gamma$ -iron oxide material. Paragraph 5 of the Official Action contains citations to In re Susi and In re Gurley in support of the proposition that the teachings of *Matsushita* would render the presently claimed invention obvious. First, it is asserted that:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. Disclosed examples and

preferred embodiments do not constitute a teaching away from broader disclosures or non-preferred embodiments.

This rationale is defective in at least two respects. First, the disclosure of *Matsushita*, when taken as a whole, does not reasonably suggest to those of ordinary skill in the art that non- $\gamma$ -iron oxide would be utilized. In this connection, the Examiner's attention is directed to lines 16-19 of column 3 of *Matsushita*:

col 3  
The component (d) or finely divided  $\gamma$ -type iron sesquioxide included in the compositions of this invention is one expressed by the chemical formula  $\gamma\text{-Fe}_2\text{O}_3$ , and this is an essential component.

Therefore, it is clear that non- $\gamma$ -type iron oxide cannot be properly characterized as a "non-preferred embodiment" as asserted in paragraph 5 of the Official Action.

In connection with the citation to In re Gurley, it is asserted that:

A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.

However, this rationale does not apply to the present situation. In particular, the composition of the presently claimed invention is not "for the same use" as the composition taught by *Matsushita*. To the contrary, the presently claimed composition was developed with an entirely different use in mind. Moreover, with regard to the comparison between comparative examples 103 and 104 of *Matsushita*, and the essential composition taught therein which includes  $\gamma$ -iron oxide, the obviousness of one with respect to the other is not an issue here.

Therefore, for at least these additional reasons, claims 4-8 and 10 are not obvious over *Matsushita*.

Claims 4-7 and 10 stand rejected under 35 U.S.C. §103(a) over *Takita et al.* on the grounds set forth in paragraph 7 of the Official Action. For at least the reasons noted below, the rejection should be withdrawn.

As noted above, *Takita et al.* fails to disclose, or even suggest, a composition recited by the presently claimed invention, which does not include the presence of azo-organic compounds as taught by *Takita et al.* Therefore, claims 4-7 and 10 are also non-obvious over *Takita et al.* for at least the same reasons noted above.

#### **CONCLUSION**

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed.

Respectfully submitted,

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